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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/083,245	02/25/2002	James W. Darrow	U 013888-7	8430

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EXAMINER

TRUONG, TAMTHOM NGO

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 12/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/083,245

**Applicant(s)**

DARROW ET AL.

**Examiner**

Tamthom N. Truong

**Art Unit**

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 5-23-02 (Prelim. Amdt).
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2-79 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 2-79 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

*Election/Restrictions*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

1. Claims 2-12, 18-41, 45, 46 and 51 (part of each), drawn to compounds of formula

I wherein:

X is N

R<sup>2</sup> does not join with R<sup>6</sup>, A, or B;

A does not join with B;

B does not join with R<sup>5</sup>

Pharmaceutical composition thereof, and method of treating cardiovascular and eating disorders using said compounds, classified in classes 514 and 544, various subclasses depending on substituents.

2. Claims 2-12, 18-41, 45, 46 and 51 (part of each), drawn to compounds of formula

I wherein:

X is N

R<sup>2</sup> join with R<sup>6</sup>, but does not join with A, or B;

A does not join with B;

B does not join with R<sup>5</sup>

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Pharmaceutical composition thereof, and method of treating cardiovascular and eating disorders using said compounds, classified in classes 514 and 544, various subclasses depending on substituents.

3. Claims 2-12, 18-41, 45, 46 and 51 (part of each), drawn to compounds of formula I wherein:

X is N

R<sup>2</sup> join with A, but does not join with R<sup>6</sup> or B;

A does not join with B;

B does not join with R<sup>5</sup>

Pharmaceutical composition thereof, and method of treating cardiovascular and eating disorders using said compounds, classified in classes 514 and 544, various subclasses depending on substituents.

4. Claims 2-12, 18-41, 45, 46 and 51 (part of each), drawn to compounds of formula I wherein:

X is N

R<sup>2</sup> join with B, but does not join with A or R<sup>6</sup>;

A does not join with B;

B does not join with R<sup>5</sup>

Pharmaceutical composition thereof, and method of treating cardiovascular and eating disorders using said compounds, classified in classes 514 and 544, various subclasses depending on substituents.

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5. Claims 2-12, 18-41, 45, 46 and 51 (part of each), drawn to compounds of formula

I wherein:

X is N

R<sup>2</sup> does not join with R<sup>6</sup>, A, or B;

A joins with B;

B does not join with R<sup>5</sup>

Pharmaceutical composition thereof, and method of treating cardiovascular and eating disorders using said compounds, classified in classes 514 and 544, various subclasses depending on substituents.

6. Claims 2-12, 18-41, 45, 46 and 51 (part of each), drawn to compounds of formula

I wherein:

X is N

R<sup>2</sup> does not join with R<sup>6</sup>, A, or B;

A does not join with B;

B joins with R<sup>5</sup>

Pharmaceutical composition thereof, and method of treating cardiovascular and eating disorders using said compounds, classified in classes 514 and 544, various subclasses depending on substituents.

7. Claims 2-12, 18-41, 45, 46 and 51 (part of each), drawn to compounds of formula

I wherein:

X is CR<sup>14</sup>;

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$R^2$  does not join with  $R^6$ , A, or B;

A does not join with B;

B does not join with  $R^5$

Pharmaceutical composition thereof, and method of treating cardiovascular and eating disorders using said compounds, classified in classes 514 and 544, various subclasses depending on substituents.

8. Claims 2-12, 18-41, 45, 46 and 51 (part of each), drawn to compounds of formula

I wherein:

X is  $CR^{14}$ ;

$R^2$  joins with  $R^6$ , but does not join with A, or B;

A does not join with B;

B does not join with  $R^5$

Pharmaceutical composition thereof, and method of treating cardiovascular and eating disorders using said compounds, classified in classes 514 and 544, various subclasses depending on substituents.

9. Claims 2-12, 18-41, 45, 46 and 51 (part of each), drawn to compounds of formula

I wherein:

X is  $CR^{14}$ ;

$R^2$  joins with A, but does not join with  $R^6$  or B;

A does not join with B;

B does not join with  $R^5$

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Pharmaceutical composition thereof, and method of treating cardiovascular and eating disorders using said compounds, classified in classes 514 and 544, various subclasses depending on substituents.

10. Claims 2-12, 18-41, 45, 46 and 51 (part of each), drawn to compounds of formula I wherein:

X is CR<sup>14</sup>;

R<sup>2</sup> joins with B, but does not join with A or R<sup>6</sup>;

A does not join with B;

B does not join with R<sup>5</sup>

Pharmaceutical composition thereof, and method of treating cardiovascular and eating disorders using said compounds, classified in classes 514 and 544, various subclasses depending on substituents.

11. Claims 2-12, 18-41, 45, 46 and 51 (part of each), drawn to compounds of formula I wherein:

X is CR<sup>14</sup>;

R<sup>2</sup> does not join with R<sup>6</sup>, A, or B;

A joins with B;

B does not join with R<sup>5</sup>

Pharmaceutical composition thereof, and method of treating cardiovascular and eating disorders using said compounds, classified in classes 514 and 544, various subclasses depending on substituents.

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12. Claims 2-12, 18-41, 45, 46 and 51 (part of each), drawn to compounds of formula

I wherein:

X is CR<sup>14</sup>;

R<sup>2</sup> does not join with R<sup>6</sup>, A, or B;

A does not join with B;

B joins with R<sup>5</sup>

Pharmaceutical composition thereof, and method of treating cardiovascular and eating disorders using said compounds, classified in classes 514 and 544, various subclasses depending on substituents.

13. Claims 14-17 and 52-79, drawn to a method of inhibiting the binding of NPY to NPY1 receptor, and a method for altering the signal-transducing activity of a cell surface NPY1 receptor, classified in class 514, various subclasses depending on substituents. Further restriction will be required if this group is elected.
14. Claims 13, drawn to a packaged pharmaceutical composition, classified in class 514, various subclasses depending on substituents. Further restriction will be required if this group is elected.
15. Claims 47-50, drawn to a pharmaceutical composition having a second compound, and methods of treatment using said composition, classified in class 514, various subclasses depending on substituents. Further restriction will be required if this group is elected.



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Inventions of groups 1-15 are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are distinct by various methods of use, and chemical structures.

a. Although the inventions of groups 1-12 share the same utility, they are drawn to compounds of different chemical structures. The common core of fused *pyrazolo* alone cannot sufficiently define the invention, and is not a contribution to the art. It is the combination of the bicycle having "X" with variables  $R^2$ ,  $R^5$ ,  $R^6$ , A and B that sets apart compounds of one group from the other. Note, the rings formed by ( $R^2$  and  $R^6$ ), or ( $R^2$  and A), or (B and  $R^6$ ), etc. can significantly give a unique physical, chemical properties as well as biological activities for the compounds of each group. Therefore, a reference reading on one group would not necessarily do so to the other groups. Thus, a separate search is required for each group.

b. The invention of group 13 is drawn to various method of use relating to various biological pathways. Again, a reference reading on the compound would not necessarily read on any of these biological pathways. So, a separate search is required for this group as well.

c. The invention of group 14 is drawn to a "packaged pharmaceutical composition" which requires a search in the packaging class also. The invention of group 15 is drawn to a pharmaceutical composition having a second compound, and method of treatment thereof, which requires a search for the second compound.

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Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, and to search the 15 distinct inventions would indeed impose a serious burden upon the examiner in charge of this invention, restriction for examination purposes as indicated is proper.

A telephone call was made to Mr. John Richards on 11-29-04 to request an oral election to the above restriction requirement, but a written restriction was requested.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamthom N. Truong whose telephone number is 571-272-0676. The examiner can normally be reached on M-F (10:00-6:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O Wilson can be reached on 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**Tamthom N. Truong**  
**Examiner**  
**Art Unit 1624**

11-29-04



**JAMES O. WILSON**

**SUPERVISORY PATENT EXAMINER**

**TECHNOLOGY CENTER (PTO)**

